



Response under 37 C.F.R. § 1.116
Expedited Procedure
Examining Group 2871

PATENT
Attorney Docket No. 041501-5443

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
In Jae CHUNG et al.)	Confirmation No.: 6711
)	
Application No.: 09/941,628)	Group Art Unit: 2871
)	
Filed: August 30, 2001)	Examiner: M. Ton
)	
For: LIQUID CRYSTAL DISPLAY PANEL)	

Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, **Mail Stop AF**
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

RESPONSE FILED UNDER 37 C.F.R. § 1.116 AND
REQUEST FOR WITHDRAWAL OF FINAL REJECTION

In response to the Final Office Action dated January 14, 2004, the period for response to which extends through April 14, 2004, favorable reconsideration and allowance of the subject application are respectfully requested in view of the following remarks.

Summary of the Office Action

Claims 1, 2, 5-8 and 23 stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over *Sawatsubashi et al.* (U.S. Patent No. 5,148,301) in view of *Wakai et al.* (U.S. Patent No. 5,166,085).

Summary of the Response to the Office Action

The finality of the Office Action is respectfully traversed.

No changes to the claims have been proposed by this response. Accordingly, claims 1, 2, 5-21 and 23 are currently pending, with claims 1, 2, 5-8, and 23 being under consideration.

Finality of the Office Action

The current Office Action has been made final. However, M.P.E.P. §706.07(h),VIII states that “[t]he action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met.” In particular, M.P.E.P. §706.07(b) sets forth that

“[t]he claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.”

A Preliminary Amendment was filed with the Request for Continued Examination under 37 C.F.R. § 1.114 on December 18, 2003 in the present application. In particular, the December 18, 2003 Preliminary Amendment newly presented claims drawn to an invention that was not claimed in the earlier application. For instance, the December 18, 2003 Preliminary Amendment presented a newly-claimed combination as set forth in independent claim 1 including at least “wherein the electrode pattern is completely embedded within the seal pattern.” Applicants respectfully submit that independent claim 1 as presented in the December 18, 2003 Preliminary Amendment contains features that were not claimed in the earlier application. Accordingly, Applicants respectfully submit that the claims presented by the December 18, 2003 Preliminary Amendment do not meet the situations set forth in M.P.E.P. §706.07(b) and the current Office

Action should not be made final. Hence, the withdrawal of the finality of the current Office Action is respectfully requested.

Claim Rejection Under 35 U.S.C. §103(a)

Claims 1, 2, 5-8, 22 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Sawatsubashi et al.* in view of *Wakai et al.* This rejection is respectfully traversed for at least the following reasons.

Applicants respectfully submit that *Sawatsubashi et al.* and *Wakai et al.*, whether taken separately or in combination, fail to teach or suggest every feature of claims 1, 2, 5-8, and 23. For example, it is respectfully submitted that neither *Sawatsubashi et al.* nor *Wakai et al.* teaches or suggests the claimed combination as set forth in independent claim 1 including at least “a seal pattern formed peripherally to said active area surrounding the electrode pattern, and contacting said first substrate and said second substrate, wherein the electrode pattern is completely embedded within the seal pattern.”

The current Office Action asserts that the seal member (108) of *Sawatsubashi et al.* completely surrounds the electrode pattern 103, “i.e., the electrode pattern 103 completely embedded with the seal pattern 108.” Paragraph 3, lines 10-11 of the current Office Action. Applicants respectfully traverse the Office Action’s assertion and request that evidence be provided in accordance with M.P.E.P. §2144.03. In fact, as shown in FIG. 4 of *Sawatsubashi et al.*, the electrode (103) neither contacts the seal member (108) nor is completely embedded within the seal member (108), as set forth in Applicants’ claimed combination.

Further, it is respectfully submitted that *Wakai et al.* is not relied upon as teaching an electrode pattern or a seal pattern. In addition, it is respectfully submitted that *Wakai et al.* also

fails to teach or suggest the claimed combination as set forth in independent claim 1 including at least “a seal pattern formed peripherally to said active area surrounding the electrode pattern, and contacting said first substrate and said second substrate, wherein the electrode pattern is completely embedded within the seal pattern.” Accordingly, Applicants respectfully submit that *Sawatsubashi et al.* and *Wakai et al.*, whether taken separately or in combination, fail to teach or suggest the claimed combination as set forth in independent claim 1 including at least “a seal pattern formed peripherally to said active area surrounding the electrode pattern, and contacting said first substrate and said second substrate, wherein the electrode pattern is completely embedded within the seal pattern.”

Since *Sawatsubashi et al.* and *Wakai et al.*, whether taken separately or in combination, fail to teach or suggest every feature of independent claim 1, as newly-amended, it is respectfully submitted that *Sawatsubashi et al.* in view of *Wakai et al.* do not render claim 1 unpatentable. Further, since claims 2, 5-8 and 23 depend from claim 1, it is respectfully submitted that *Sawatsubashi et al.* in view of *Wakai et al.* also do not render claims 2, 5-8 and 23 unpatentable.

In addition, it is respectfully submitted that dependent claims 2, 5-8 and 23 are allowable also because *Sawatsubashi et al.* in view of *Wakai et al.* fail to teach or suggest features of these claims. For instance, it is respectfully submitted that *Sawatsubashi et al.* in view of *Wakai et al.*, whether taken separately or in combination, fail to teach or suggest the claimed combination as set forth in claim 7 including at least “wherein said electrode pattern forms an electric field with said common electrode,” and the claimed combination as set forth in claim 8 including at least “wherein said electrode pattern is applied with a constant DC bias voltage.”

The current Office Action asserts that “[a]n operation LCD device comprises a mode in which an E-field is applied between the upper(common) electrode and the lower(pixel) electrode,” and “TFT(s) serves [as] a switching means to the pixel electrode.” Paragraph 3, lines 12-14 of the current Office Action. However, Applicants respectfully submit that *Sawatsubashi et al.* and *Wakai et al.* neither teach nor suggest the electrode pattern forming an electric field with the common electrode, wherein the electrode pattern is completely embedded within the seal pattern, as set forth in Applicants’ claim 7. In addition, Applicants respectfully submit that *Sawatsubashi et al.* and *Wakai et al.* neither teach nor suggest the electrode pattern being applied with a constant DC bias voltage, wherein the electrode pattern is completely embedded within the seal pattern, as set forth in Applicants’ claim 8.

Moreover, it is respectfully submitted that *Sawatsubashi et al.* and *Wakai et al.*, whether taken separately or in combination, fail to teach or suggest the claimed combination as set forth in claim 23 including at least “wherein said electrode pattern contacts only said seal pattern and said protective film.” In fact, as shown in FIG. 4 of *Sawatsubashi et al.*, the bottom surface of electrode (103) contacts the lower substrate (101), the side surfaces of the electrode (103) contact the TFT (104) and the aligning film (106), while the top surface of the electrode (103) contacts the aligning film (106). See also, FIG. 11 of *Sawatsubashi et al.* Thus, even assuming there exists motivation or suggestion in prior art to modify the teaching of *Sawatsubashi et al.* to form an insulating layer between the pixel electrode (103) and the drain electrode (104), as asserted by the Office Action at paragraph 2, lines 21-24, such a modified arrangement would still fail to teach or suggest the electrode pattern contacting only the seal pattern and the protective film, as set forth in Applicants’ claim 23. Accordingly, Applicants respectfully submit that *Sawatsubashi*

et al. and *Wakai et al.*, whether taken separately or in combination, fail to teach or suggest the claimed combination as set forth in claim 23 including at least “wherein said electrode pattern contacts only said seal pattern and said protective film.”

In light of the above, withdrawal of the rejection of claims 1, 2, 5-8 and 23 under 35 U.S.C. §103(a) is respectfully requested.

Conclusion

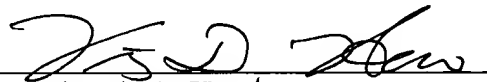
In view of the foregoing, withdrawal of the rejections and allowance of the pending claims are earnestly solicited. Should there remain any questions or comments regarding this response or the application in general, the Examiner is urged to contact the undersigned at the number listed below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,
MORGAN, LEWIS & BOCKIUS LLP

Dated: April 14, 2004

By: _____



Victoria D. Hao

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Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

RESPONSE FILED UNDER 37 C.F.R. §1.116 AND
REQUEST FOR WITHDRAWAL OF FINAL REJECTION TRANSMITTAL FORM

1. Transmitted herewith is a Response filed under 37 C.F.R. §1.116 and Request for Withdrawal of Final Rejection in response to the Final Office Action dated January 14, 2004.

2. Additional papers enclosed:

- ☐ Information Disclosure Statement
- ☐ Form PTO-1449, _____ references included
- ☐ Citations
- ☐ Declaration of Biological Deposit
- ☐ Submission of "Sequence Listing", computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.

3. Extension of Time

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136(a) apply.

☒ Applicants believe that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicants have inadvertently overlooked the need for a petition and fee for extension of time.

☐ Applicants petition for an extension of time, the fees for which are set out in 37 C.F.R. § 1.17(a), for the total number of months checked below:

<u>Total Months Requested</u>	<u>Fee for Extension</u>	<u>[Fee for Small Entity]</u>
<input type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 420.00	\$ 210.00
<input type="checkbox"/> three months	\$ 950.00	\$ 475.00
<input type="checkbox"/> four months	\$ 1,480.00	\$ 740.00

Extension of time fee due with this request: \$_____.

If an additional extension of time is required, please consider this a Petition therefor.

☐ An extension for _____ months has already been secured and the fee paid therefor of \$_____ is deducted from the total fee due for the total months of extension now requested.

4. Constructive Petition

☒ EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

5. Fee Calculation (37 C.F.R. §1.16)

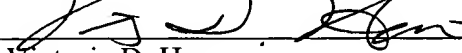
CLAIMS AS AMENDED						
	Claims Remaining After Amendment		Highest No. Previously Paid	Present Extra	at Rate of	Total Fees
Total Claims (37 C.F.R. §1.16(c))	21	minus	21	0	x \$18 each=	+ \$0.00
Independent Claims (37 C.F.R. §1.16(b))	2	minus	3	0	x \$86 each=	+ \$0.00
[] First presentation of Multiple dependent claim(s)					\$290.00	+ \$0.00
SUB-TOTAL =						\$0.00
Reduction by ½ for filing by a small entity						- \$0.00
TOTAL FEE =						\$0.00

6. Fee Payment

- ☒ No fee is to be paid at this time.
- ☐ Please charge Deposit Account No. 50-0310 the amount of \$_____ for the extension of time fee or fee for claims.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, including fees due under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account 50-0310.

Respectfully submitted,
MORGAN, LEWIS & BOCKIUS LLP

Dated: April 14, 2004

By: 
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 Registration No. 47,630

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